

## REMARKS

Applicants respectfully request reconsideration of the present U.S. Patent application as amended herein.

### Claim Rejection - 35 U.S.C. § 112, Second Paragraph

Claim 12 was rejected as lacking proper antecedent basis for the limitation “operating the client device...” Claim 12 has been amended to provide proper antecedent basis. Accordingly, Applicants request that the rejection of claim 12 under 35 U.S.C. § 112, Second Paragraph be withdrawn.

### Claim Rejections - 35 U.S.C. § 103(a)

Claims 1-7, 12-21, 23-28 and 31-46 were rejected as being unpatentable over U.S. Patent No. 6,167,446 issued to Lister, et al. (*Lister*) in view of U.S. Patent No. 5,828,830 issued to Rangaraian, et al. (*Rangaraian*). Claim 22 has been canceled without prejudice. Therefore, the rejection of claim 22 is moot. For at least the reasons set forth below, Applicants submit that claims 1-7, 12-21, 23-28 and 31-46 are not rendered obvious by *Lister* and *Rangaraian*.

Claim 1 recites:

requesting, with a local device, configuration services from a remote device coupled to the network in response to connecting the local device to the network;

operating the local device as a configuration services server to provide configuration services to one or more remote devices of said network if the response to said configuration information request is not received by the local device from said remote device within a predetermined period of time or if the response to said configuration information request is received by the local device from said remote device within the predetermined period of time and the response indicates that the local device has a higher priority than the remote device; and

operating the local device as a configuration services client to receive configuration services from said remote device with the local

device as a client device if the response is received within the predetermined period of time and said remote device has a higher priority than said local device.

Thus, Applicants claim selectively operating a local device as a configuration services client or a configuration services server. The local device operates as a configuration services server under certain conditions and the local device operates as a configuration services client under other conditions. Claim 31 is a means-plus-function claim and recites similar limitations.

*Lister* is directed to a network proxy cache that ***provides*** tracking of names. See, for example, the Summary of the Invention. Specifically, *Lister* states:

The present invention provides automatic configuration for proxy caches such as network-infrastructure caches.

See col. 3, lines 39-40. *Lister* does not disclose a device that ***provides or receives configuration services***. The device discloses by *Lister provides* name services at all times. The device does not receive configuration services under any condition. Therefore, *Lister* cannot teach or suggest the method as set forth in claims 1 and 31.

*Rangaraian* is cited merely to disclose comparing priorities. *Rangaraian* specifically discloses prioritization and filtering of network traps. See Abstract. *Rangaraian* does not address selectively providing configuration services. Therefore, *Rangaraian* does not cure the deficiencies of *Lister*. Because neither *Lister* nor *Rangaraian* disclose a device that provides configuration services under certain conditions and receives configuration services under other conditions, no combination of *Lister* and *Rangaraian* can teach or suggest the invention as claimed in claims 1 and 31.

The Office Action states:

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to determine the priority of devices connected to

the network in order to identify the appropriate states of devices in the network *before making decision of whether or not necessarily to provide configuration service.*

See page 3 (emphasis added). Whether or not this statement is true, the Office Action still fails to address selectively providing *or* receiving configuration services with a single device. Thus, even following the modifications and suggestions set forth in the Office Action, *Lister* and *Rangaraian* would not result in the invention as claimed in claim 1.

Moreover, to establish *prima facie* obviousness, the Office Action must show that there is some motivation, suggestion or teaching of the desirability of the combination of references proposed in the Office Action. See *In re Kotzab*, 55 USPQ 2d 1313 (Fed. Cir 2000). The motivation provided in the Office Action of November 18, 2002 fails to meet the requirements set forth in *Kotzab*. Therefore, the Office Action fails to provide a *prima facie* case of obviousness.

Claims 2-7 depend from claim 1. Claims 32-37 depend from claim 31. Because dependent claims include the limitations of the claims from which they depend, Applicants submit that claims 2-7 and 32-37 are not rendered obvious by *Lister* and *Rangaraian* for at least the reasons set forth above.

Claim 12 recites:

determining service capability of said local device including whether said local device is capable of providing configuration services to one or more remote devices of said network;  
providing configuration services to one or more devices from the local device of said network if configuration services are not provided by a network device having a higher priority than said local device; and  
operating the client device as a client device to receive configuration services from a remote device if said remote device has a higher priority than said local device.

Thus, Applicants operating a local device to selectively either provide configuration services or to receive configuration services.

As discussed above, not combination of *Lister* and *Rangaraian* teaches or suggests operating a device, or a device itself, to provide configuration services under a first set of conditions and to receive configuration services under a second set of conditions. Therefore, no combination of *Lister* and *Rangaraian* can teach or suggest the invention as claimed in claim 12.

Claims 13-20 depend from claim 12. Because dependent claims include the limitations of the claims from which they depend, Applicants submit that claims 13-20 are not rendered obvious by *Lister* and *Rangaraian* for at least the reasons set forth above.

Claim 21 recites the following:

- receive a first network address from a second device coupled to said network;
- operate as a server device to provide network configuration services if said first network address is not received from said second device within a predetermined period of time;
- determine its priority level on said network if said first network address is received from said second device;
- operate as a server device to provide said network configuration services if said priority level is higher than a second priority level of said second device; and
- operate as a client device to receive configuration services from said remote device if said remote device has a higher priority than said device.

Thus, Applicants claim a device that selectively operates as a client device or a server device based on whether a response is received and the priority level of the device providing the response, if any. Claim 26 similarly recites determining which of multiple devices provides configuration services. Claim 38 is a means-plus-function claim that recites similar limitations.

As discussed above, no combination of *Lister* and *Rangaraian* teach or suggest a device that selectively operates as a client or a server based on responses from remote

devices and priority levels. Therefore, no combination of *Lister* and *Rangaraian* teaches or suggests the invention as claimed in claims 21, 26 and 38.

Claims 23-25 depend from claim 21. Claims 27 and 28 depend from claim 26. Claims 39-46 depend from claim 38. Because dependent claims include the limitations of the claims from which they depend, Applicants submit that claims 23-25, 27, 28 and 39-46 are not rendered obvious by any combination of *Lister* and *Rangaraian* for at least the reasons set forth above.

#### Conclusion


For at least the foregoing reasons, Applicants submit that the rejections have been overcome. Therefore, claims 1-7, 12-21, 23-28 and 31-46 are in condition for allowance and such action is earnestly solicited. The Examiner is respectfully requested to contact the undersigned by telephone if such contact would further the examination of the present application.

Please charge any shortages and credit any overcharges to our Deposit Account number 02-2666.

Respectfully submitted,  
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